

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN W. FRANK and CHARLES A. MATHNA

Appeal No. 95-4120
Application No. 07/943,901¹

ON BRIEF

Before JOHN D. SMITH, PAK and KRATZ, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

Appellants seek review under 35 U.S.C. § 134 from the final rejection of claims 1-5 and 9-16, all of the pending claims.

¹ Application for patent filed September 11, 1992.

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Claim 1 is representative and is reproduced below:

1. A sheet material for mounting on a substrate and displaying an article, comprising a substantially smooth, flexible film backing, a coating of a first repositionable adhesive on a first major surface of said backing for removably adhering said sheet material to said substrate, and a coating of a second repositionable adhesive on a second major surface of said backing for adhering said article to said sheet material, said first repositionable adhesive coating providing a higher level of adhesion per unit area of said sheet material than said second repositionable adhesive coating by virtue of said first repositionable adhesive being more aggressive an adhesive than said second repositionable adhesion(sic, adhesive) such that the adhesion level provided by said first repositionable adhesive coating is at least about 50 gram/cm width higher than that provided by said second repositionable adhesive coating when tested according to Test Method A, and the adhesion level provided by said second repositionable adhesive coating is about 30 to about 55 gram/cm width when tested according to Test Method A, such that when said first repositionable adhesive coating is contacted with said substrate to which said sheet material is being adhered, said article which is being adhered to said second repositionable adhesive coating can be repositioned thereon and removed therefrom without removing said sheet material from said substrate.

The references of record relied upon by the examiner are:

Loggins	4,950,517	Aug.
21, 1990		
Merrill, Jr. et al. (Merrill)	3,857,731	Dec.
31, 1974		

Claims 1, 9, and 16 stand rejected under 35 U.S.C.

§ 102(b) as anticipated by Loggins. Claims 2 and 3 stand rejected under 35 U.S.C. § 103 as obvious over Loggins in view

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of Merrill. Claims 4, 5, and 10-15 stand rejected under 35 U.S.C. § 103 as unpatentable over Loggins.

We cannot sustain the stated rejections.

The subject matter on appeal is directed to a sheet material to be mounted on a substrate (e.g., a wall) for displaying an article (e.g., a greeting card or a photograph), comprising a flexible film backing having a first repositionable adhesive on one surface and a second repositionable adhesive on the other surface. The adhesion level provided by the first repositionable adhesive is at least about 50 gram/cm width higher than that provided by the second repositionable adhesive when tested in accordance with a referenced test method (Test Method A as described in the specification at page 8, lines 10-37) and the second repositionable adhesive coating provides an adhesion level of about 30 to about 55 gram/cm width under the same test. When the sheet material is adhered to a wall by means of the first repositionable adhesive coating, the greeting card or photograph can be repositioned thereon or removed therefrom without removing the sheet from the wall.

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The examiner's prior art rejections are based on the contention that the adhesion levels of the adhesive coatings on the lower and upper faces of the stickers described in Loggins

(coatings 38 and 40 in Figures 2 and 3) must inherently fall within the Test Method A adhesion level ranges called for by the appealed claims because, according to the examiner, the stickers are used in a similar fashion to that of the claimed sheet material and, if adhesion levels outside the claimed ranges were used, the stickers of Loggins would not properly function.

Inherency, however, may not be established by probabilities or possibilities. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). While it may be possible that the adhesive coatings of Loggins' stickers, which are particularly useful for adhering a sheet of drafting paper or film to a drafting table, inherently possess adhesion levels corresponding to the levels claimed, that "possibility" is not sufficient to establish a prima facie case of inherency. Here, because of a paucity of detailed and specific disclosures regarding the adhesive compositions of Loggins, a

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comparative factual analysis between the claimed adhesives and the adhesives of Loggins, such as made in In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), cannot be undertaken. Accordingly, the examiner's stated rejections of the appealed claims cannot be sustained.

REMAND

This application is remanded to the examiner to consider a rejection of at least independent claims 1 and 16 under 35 U.S.C. § 103 over Loggins based on the rationale that the parameter of adhesive strength (level) for the respective adhesive coatings on the upper and lower faces of the stickers described in Loggins would have been recognized by one of ordinary skill in this art as a result effective variable in light of the disclosures in Loggins at column 1, lines 15-20; column 1, line 66 to column 2, line 8; column 2, lines 26-40; column 3, lines 20-31; column 4, lines 17-30; and column 5, lines 29-36. Ordinarily, the discovery of a workable or optimum value of a result effective variable(parameter) is within the skill of the art. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). Consideration should also be

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given to the fact that Test Method A, which defines the adhesive levels of the claimed adhesives, is a conventional method used in the art as set forth in the specification at page 8, lines 10-37.

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The decision of the examiner is reversed and the application is remanded for consideration of the issues raised above.

This application, by virtue of its special status requires an immediate action. Manual of Patent Examining Procedure § 708.01(d)(7th ed., July 1998). It is important that the Board be informed promptly of any action affecting in this case.

REVERSED/REMANDED

JOHN D. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

jrg

Robert W. Sprague
3M Office of Intellectual Prop. Counsel
P.O. Box 33427
St. Paul, MN 55133-3427